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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/520,368	03/07/2000	Tetsuro Motoyama	5244-0114-2	9637

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EXAMINER

EL HADY, NABIL M

ART UNIT PAPER NUMBER

2154

DATE MAILED: 06/24/2004

15

Please find below and/or attached an Office communication concerning this application or proceeding.

SK

# Office Action Summary

Application No.

09/520,368

Applicant(s)

MOTOYAMA ET AL.

Examiner

Nabil M El-Hady

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-6, 9-16, 19-26 and 29-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1-6, 9-16, 19-26 and 29-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 10.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

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1. Claims 1-1-6, 9-16, 19-26, and 29-33 are pending in this application.

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-1-6, 9-16, 19-26, and 29-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cantwell (US 6,542,892).

4. As to claims 1 and 11, Cantwell discloses the invention substantially as claimed including a method and a system, the method comprising monitoring a first device (PRINTER 12, or PRINTER MANUFACTURING SERVER 26, Fig. 1) by a second device (PRINT SERVER 10 / or DRIVER SERVER 18, Fig. 1); determining, by the second device, whether a current device driver in the first device is a desired device driver (col. 2, lines 40-41,42-44); first transferring the desired device driver from the second device to the first device (col. 2, lines 40-55) when it is determined that the current device driver in the first device is different from the desired device driver (col. 2, lines 40-55), wherein the current device driver and the desired device driver are configured to control operations of the first device (col. 2, lines 40-41); determining whether a user of a third device (CLIENT 4, Fig. 1) desires the desired device driver to be transferred to the third device; when the user of the third device accesses the first device (PRINTER 12 through PRINT SERVER 10, Fig. 1); and second transferring the desired device driver from the first device to the third device when it is determined that the user of the third

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device desires the desired device driver to be transferred to the third device (col. 2, lines 25-26, 41-42, 55-61; and col. 3, lines 14-20, 45-50); wherein the desired device driver is configured to control operations of the first device by the user of the third device (col. 2, lines 41-42).

5. Examiner notes that a first device may be looked at as the printer 12, print server 10, a printer manufacturing server 26, a combination of the printer 12 and the print server 10, a combination of the print server 10 and the driver server 18, a combination of driver server and printer manufacturer server 26, or a combination of all printer 12, print server 10, and driver server 18. A second device may be looked at also as one of the above arrangements. While a third device may be looked at as the client 4. It would have been obvious to one skilled in the art at the time of the invention to consider and argue that the relation and transfer of information between the first device and the second device may take any of the previous arrangements to read on the claimed invention.

6. As to claims 9 and 19, the claims are rejected for the same reasons as claims 1 and 11 above. In addition, Cantwell discloses a method and a system, the method comprising determining whether a user of a first device (CLIENT 4, Fig. 1) desires a desired device driver of a second device (e.g. PRINTER 12, Fig. 1) to be transferred to the first device (by identifying a printer to serve the client, steps 32, 34, 38, 40, 42, 44, Fig. 2) when the user of the first device accesses the second device (col. 2, lines 20-30, 55-61); and transferring the desired device driver from the second device to the first device (Fig. 2) when it is determined that the user of the first device desires the desired device driver of the second device to be transferred to the first device (col. 3, lines 14-21); wherein the desired device driver is configured to control operations of the second device by the first device (col. 2, lines 41-42); wherein the second

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device ( e.g. PRINTER 12, Fig. 1) is monitored by a third device (PRINT SERVER 10 / or DRIVER SERVER 18, Fig. 1) to determine whether a current device driver in the second device is the desired device driver, and to transfer the desired device driver from the third device to the second device (col. 2, lines 40-55) when it is determined that the current device driver in the second device is different from the desired device driver (col. 2, lines 40-55 ), wherein the current device driver and the desired device driver are configured to control operations of the second device (col. 2, lines 40-41).

7. As to claim 21, the claim is rejected for the same reasons as claims 1 and 11 above. In addition, a program product including a computer readable medium embodying program instructions for causing a system to perform the claimed method steps is inherent in Cantwell disclosure.

8. As to claim 29, the claim is rejected for the same reasons as claims 9 and 19 above. In addition, a program product including, a computer readable medium embodying program instructions for causing a system to perform the claimed method steps, is inherent in Cantwell disclosure.

9. As to claims 2, 12, and 22, the claims are rejected for the same reasons as claims 1, 11, and 21 above. In addition, Cantwell discloses first transferring the desired device driver from the second device to the first device using at least one of a direct connection message, a network mail message and an electronic mail message (col. 2, lines 47-54; and col. 3, lines 30-34).

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10. As to claims 3, 13, and 23, Cantwell discloses the first device (PRINTER 12, or PRINTER MANUFACTURING SERVER 26, Fig. 1) is connected to a first network and the second device (PRINT SERVER 10 / or DRIVER SERVER 18, Fig. 1) is connected to a second network (Firewall 11 connects the two networks in Fig. 1).

11. As to claims 4, 14, and 24, Cantwell discloses the first and second networks are connected by a third network (the internet, col. 2, lines 18-19).

12. As to claims 5, 15, and 25, the claims are rejected for the same reasons as claims 1, 11, and 21 above. In addition, Cantwell discloses that transferring the desired device driver includes transferring information regarding the desired device driver (col. 2, lines 66-67).

13. As to claims 6, 10, 16, 20, 26, and 30, it is inherent in Cantwell's disclosure that transferring the capabilities of the desired device driver (col. 2, lines 66-67) includes transferring information regarding the desired device driver. This information may include the version of the device driver, the effective date of the desired device driver, and an indication of an operating system for the desired device driver.

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Kisono (US 6,614,548); Iida (US 6,671,063); Yeung et al. (US 6,690,481); and Cheng et al. (US 6,151,643).


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15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nabil M El-Hady whose telephone number is (703) 308-7990. The examiner can normally be reached on 9:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703) 305-8498. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

June 17, 2004



Nabil El-Hady, Ph.D, M.B.A.  
Primary Patent Examiner  
Art Unit 2154